

REMARKS/ARGUMENTS

Claims 22-42 are pending in the above identified application. Claims 22-42 stand rejected. No claims have been amended, cancelled, or added. No new matter has been added. For the reasons set forth below, Applicant respectfully requests that the Examiner reconsider the rejections and allow all of the pending claims.

Obvious-type Double Patenting

Claims 22, 29 and 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of co-pending Application No. 10/645,487 to Jameson, U.S. Publication No. US2005/0044095 A1. A terminal disclaimer in compliance with 37 CFR 1.321(c) is filed herewith to overcome the provisional rejection as the conflicting application is shown to be commonly owned with this application.

Claim Rejections Under 35 U.S.C. 103(a)

On page 7 of the Office Action, claims 22-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sundararajan, US 6,487,577 ("Sundaranrajan").

To establish a *prima facie* case of obviousness, the Examiner must make three basic showings. The basic criteria for establishing a *prima facie* case of obviousness are articulated in M.P.E.P. § 2142. *See also* M.P.E.P. §§ 706.02(j), 2143-2143.03; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). First, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.*

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.*

The teaching or suggestion to modify the reference and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143 - §2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP §706.02(j). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

It is further respectfully noted that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *Ex Parte Kume, et al*, 2006 WL 2558178 (Bd. Pat. App. & Interf. 2006) citing to *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). The Supreme Court continues to caution that "A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning" *KSR*, 127 S.Ct. at 1742 (citations omitted).

Independent claims 22, 29 and 36

More specifically, the Office Action asserts that Sundararajan discloses a collection, "wherein the collection includes collection specifier information and collection content

information" (Office Action at page 5, citing Sundararajan at column 4, lines 22-28 and referring to the term "job-shop"). However, the cited passage does not disclose, teach or suggest this element, only that: "Each job-shop transmitted to the NRS computer preferably includes information about the computer speed and capabilities in executing each job or task. The published information allows the NRS computer to review the published capabilities of each SC computer and choose an SC computer which is available and capable of efficiently performing the tasks corresponding to the job." From the cited passage, Sundararajan discloses a "job-shop" which includes information about the computer speed and capabilities in executing each job or tasks. On the other hand, Applicant claims a collection, which "includes *collection specifier information* and collection content information." (emphasis added)

The present application recites:

The term "collection specifier" refers to an inventive data structure that contains information about a collection instance. For example, *collection specifiers may define such things as a collection type, a text summary description of the collection, collection content members, derivable output products, collection processing information such as processing parallelism limits, special collection processing steps, and program option overrides for programs that manipulate collections.* Collection specifiers are typically implemented as simple key-value pairs in text files or database tables.

U.S. Publication No. 20050044067 A1, Paragraph 14 (emphasis added)

Therefore, at the very least, Sundararajan does not disclose, teach or suggest "collection specifier information" as disclosed by Applicant, and required by the element "collection" as claimed by Applicant in claim 22.

Independent claims 29 and 36 also include the element "collection," and in both instances have included the limitation "wherein the collection includes collection specifier information and collection content information."

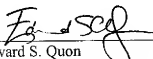
Therefore, based at least on the reasons above, Applicant respectfully submits that claims 23-26, which depend from claim 22, claims 30-35 which depend from claim 29, and claims 37-42, which depend from claim 36, are patentable over Sundararajan as applied to claims independent claims 22, 29 and 36.

CONCLUSION

On the basis of the above remarks, reconsideration and allowance of all the pending claims is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below. The Office is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1847.

Dated: January 7, 2008

Respectfully submitted,

By 
Edward S. Quon
Registration Number: 52,144
Manatt, Phelps & Phillips, LLP
1001 Page Mill Road - Building 2
Palo Alto, California 94304-1018
Telephone: 650-812-1371
Facsimile: 650-213-0260